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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,950	10/30/2003	Frans A. Audenaert	59350US002	9067

32692 7590 01/26/2006

3M INNOVATIVE PROPERTIES COMPANY  
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ST. PAUL, MN 55133-3427

EXAMINER
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NWAONICHA, CHUKWUMA O

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	Application No. 10/696,950	Applicant(s) AUDENAERT ET AL.	
	Examiner Chukwuma O. Nwaonicha	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____.<br>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)<br>6) <input type="checkbox"/> Other: _____. |
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## **DETAILED ACTION**

### ***Current Status***

1. This action is responsive to Applicants' amendment of 17 October 2005.
2. Receipt and entry of Applicants' amendment is acknowledged.
3. Claims 1-11 are pending in the application.

### ***Claim Rejections - 35 USC § 102***

The rejection of claim 1-11 under 35 U.S.C 102, as being anticipated by Bartlett, {US 3,839,425} set forth in the previous Office Action of 5/23/05 is withdrawn in favor of the new rejection.

### ***New Rejections***

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

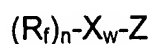
The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims** 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartlett, {US 3,839,425}.

Applicants' claim a composition or fire-fighting agent comprising an organic or aqueous liquid having dissolved or dispersed therein a mixture of fluorinated polyether of the general formula I;

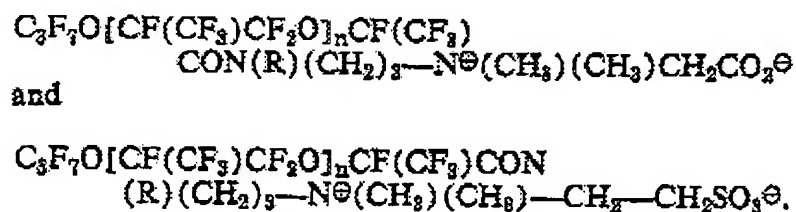


formula I,

wherein all the variables are as defined in the claims.

**Determination of the scope and content of the prior art (M.P.E.P. §2141.01)**

Bartlett teaches an aqueous fire extinguishing composition of fluorinated polyether compounds shown below. See columns 7 and 8, examples 22-24.



**Ascertainment of the difference between the prior art and the claims (M.P.E.P. §2141.02)**

Bartlett composition of fluorinated polyether compounds differs from the instantly claimed composition or fire-fighting agent in that applicants claim a composition with organic liquid selected from the group consisting of polar solvents (alcohols, ketones, esters, ethers and amides), non-polar solvents selected from the group consisting of aromatic and aliphatic hydrocarbon solvents and halogenated solvents selected from the group consisting of hydrofluoroethers, hydrofluorocarbons and chlorinated

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hydrocarbons while Bartlett composition comprising of water as solvent, NaOH and HCl.

**Finding of prima facie obviousness--rational and motivation (M.P.E.P. §2142-2143)**

The instant claimed composition of fluorinated polyether compounds would therefore have been suggested to one of ordinary skill because one wishing to obtain a fire extinguishing composition is taught to select the composition of Bartlett.

One of ordinary skill in the art would have a reasonable expectation of success in practicing the instant invention by formulating a composition of fluorinated polyether compounds in the presence of a solvent to arrive at the instantly claimed composition. Said person would have been motivated to practice the teaching of the reference cited because it demonstrates that the composition can be varied as desired. It should be noted that the variation of the composition of matter is a common laboratory technique for composition optimization and for economic reasons. Examiner notes that applicant recites the weight average molecular weight of the claim composition while Bartlett is silent about this physical property of the fluorinated polyether. However, there is nothing in record that clearly indicates that the fluorinated polyether of Bartlett does not have weight average molecular weight between 750 g/mol and 5000 g/mol. Thus, the recitation of the weight average molecular weight is not a patentable distinction because one of ordinary skill is taught to formulate an aqueous composition of fluorinated polyether compounds aqueous for fire extinguishing.

Additionally, it is prima facie obvious to combine two compositions each of which is taught by prior art to be useful for same purpose in order to form third composition that is to be used for very same purpose; idea of combining them flows logically from their having been individually taught in prior art; thus, claims that require no more than mixing together of two conventional spray-dried detergents set forth prima facie obvious subject matter. See *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chukwuma O. Nwaonicha whose telephone number is 571-272-2908. The examiner can normally be reached on Monday thru Friday, 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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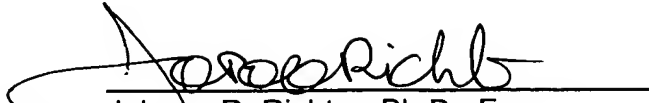
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Chukwuma O. Nwaonicha, Ph.D.

Patent Examiner

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Johann R. Richter, Ph.D., Esq.  
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